

REMARKS

The Present Invention

The present invention provides a compound of SEQ ID NO: 1, which compound (a) binds an Src homology 2 (SH2) domain in a protein comprising an SH2 domain, (b) is non-phosphorylated, (c) is redox-stable *in vivo*, (d) is characterized by an IC₅₀ *in vivo* of less than about 4.0 μ M when the target protein is growth factor receptor-bound protein 2 (Grb2), and (e) has a turn conformation upon binding to Grb2.

The Pending Claims

Claims 1, 2, 5, 6, and 9 currently are pending. Claims 1 and 2 are directed to the above-described compound. Claims 5 and 6 are directed to a conjugate comprising the compound and a carrier agent. Claim 9 is directed to a composition comprising the compound or conjugate.

Amendments to the Specification and Claims

The specification has been amended to include reference to U.S. Provisional Patent Application No. 60/137,187, and International Patent Application No. PCT/US00/15201, to which the subject application claims priority.

Claims 3, 4, 7, 8, and 10-22 have been cancelled as being drawn to a non-elected invention. Applicants reserve the right to pursue any canceled subject matter in a continuation, continuation-in-part, divisional, or other application. Cancellation of any subject matter should not be construed as abandonment of that subject matter.

Accordingly, no new matter has been added by way of the amendments to the specification and claims.

The Office Action

The application allegedly lacks the necessary reference to a prior provisional application to which the subject application claims priority. Claims 1, 2, 5, 6, and 9 are rejected under 35 U.S.C. 112, first paragraph, for an alleged lack of enablement. Reconsideration of this rejection is hereby requested.

Discussion of Rejection Under 35 U.S.C. 112, First Paragraph

The Office Action contends that claims 1, 2, 5, 6, and 9 are not enabled by the subject application because the specification does not provide any guidance to one of ordinary skill in the art for administering the compound of SEQ ID NO: 1 to prevent breast cancer.

Specifically, the Office Action contends that the *in vivo* IC₅₀ requirement of claim 1 contemplates administration of the peptide for the treatment of cancer, and that the specification is said to lack any teachings on how one of ordinary skill in the art can use the compound of SEQ ID NO: 1 as a therapeutic against breast cancer or any other disease.

Applicants submit that claim 1, and claims 2, 5, 6, and 9 depending therefrom, are directed to a *compound* of SEQ ID NO:1, and not a *method* of using the compound of SEQ ID NO: 1 as alleged in the Office Action. In this regard, the elements of claim 1 that refer to certain *in vivo* properties of SEQ ID NO:1 are merely inherent properties of any compound encompassed by the generic amino acid sequence of SEQ ID NO:1, which, Applicants assert, is enabled by the specification of the subject application, as evidenced by Examples 4-6 and 12. Indeed, the Office Action concedes the enablement of the compound defined by claim 1 when it states “[t]he specification teaches how to synthesize a peptide with SEQ ID NO: 1 and provides guidance to one of ordinary skill in the art to add “L” moiety as a sulfoxide (SO) and a signal peptide as a carrier agent (examples 4 and 12)” (see paragraph bridging pages 4 and 5 of Office Action). Thus, based on the disclosure of the subject application, one of ordinary skill in the art would be able to make and use the compound defined by claim 1 without undue experimentation.

Thus, the pending claims are enabled by the specification of the subject application. Accordingly, the enablement rejection under Section 112, first paragraph, is improper and should be withdrawn.

Conclusion

The application is considered in good and proper form for allowance, and the Examiner is respectfully requested to pass this application to issue. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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